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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,752	03/30/2000	Jay S. Walker	99-075	8956
22927	7590	07/13/2005	EXAMINER	
WALKER DIGITAL			RADA, ALEX P	
FIVE HIGH RIDGE PARK			ART UNIT	
STAMFORD, CT 06905			PAPER NUMBER	

3714

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/538,752

Applicant(s)

WALKER ET AL.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-10, 12-16, 18-24 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12-16, 18-24 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

In response to the amendment filed April 27, 2005 in which the applicant previously canceled claims 11 and 35-39, cancels claims 5, 17, and 25-30, amends claims 1, 31, and 33, and claims 1-4, 6-10, 12-16, 18-24, and 31-34 are pending in this application.

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the element of the random outcome is statistically independent of said hand of blackjack prior to the said push in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-4, 6-10,12-16, 18-24, 31-32, and 34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Useful, Concrete and Tangible Analysis

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, claims 1-4, 6-10,12-16, 18-24, 31-32, and 34 provides a useful result, which the result can be used for a purpose and a tangible result in that the determination of a hand or a plurality of hands or the like are reasonable expectation of success. Claims 1, 3-4, 6-10,12-16,17-24, 31-32, and 34 do not constitute a concrete result. Although a determination is made regarding the hand or a plurality of hands blackjack, the result is never functionally used or displayed. Applicants have added the language of, "displaying an indication of the random outcome to the player", however displaying an indication can be broadly interpreted to just be a dealer pointing to the something like cards on the table or to a pair of die. The result of the push is decided,

however, the winner is never notified of a result. Claim 2 is concrete because the player is receiving a payment of a winning amount based on the wager amount.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-4, 6-10, 12-16, and 18-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 1, the language of, "generating an additional random outcome" is vague and indefinite because an initial random outcome or a first random outcome must take place before a second or additional random outcome occurs. As more cards are dealt from a deck the deck becomes more deterministic and less random. Therefore, the limitation reciting the generation of an additional random outcome from a deck that is becoming more deterministic causes confusion about the claim and renders the claim indefinite.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 6-10, 12-16, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hesse (US 5,803,460) in view of Feola (US 5,746,432).

9. Hesse discloses the following:

A card game similar to the principles of blackjack including dealing a first set of accumulated cards to a player, dealing a second set of accumulated cards to a dealer, determining that the hand of blackjack has resulted in a push (figures 6-8), in response to the determining, generating an additional random outcome, in which the examiner interprets the player and dealer drawing one additional card to be an equivalent to an additional random outcome and *displaying an indication of the random outcome to the player*, in which the examiner interprets the player and dealer drawing additional cards to be equivalent to *displaying an indication of the random outcome to the player (column 6, lines 9-13)*, and based on the random outcome, and determining if the player has won the hand of blackjack (column 6, lines 10-13, column 13, lines 44-46, and figures 6-8) as recited in claim 1.

Receiving from the player an indication of a wager amount associated with the hand of blackjack, the receiving being performed prior to the determining that the hand of blackjack resulted in the push and after the determining if the player has won the hand of blackjack, arranging for the player to receive payment of a winning amount based on the wager

amount (column 6, lines 10-13 and column 13, lines 44-46 and figures 6-8) as recited in claim 2.

Deciding if the push will be resolved (column 6, lines 9-13 and figures 6-8) as recited in claim 3.

Determining that the hand of blackjack has resulted in the push, the player indication of whether the push will be resolved (column 6, lines 9-13 and figures 6-8) as recited in claim 4.

Generating the random outcome, in which the examiner interprets the drawing one additional card to be an equivalent to the generating the random outcome (column 6, lines 9-13) as recited in claim 7.

The generating is performed after and in response to the determining that the hand of blackjack has resulted in the push (column 6, lines 10-13 and column 13, lines 44-46) as recited in claims 8-9.

The generating is performed using a set of playing cards and the a set used in the hand of blackjack (column 6, lines 9-13) as recited in claim 16

Arranging for the player to receive payment of a winning amount as recited in claim 19.

The winning amount is based at least in part on the random outcome (column 6, lines 24-32) as recited in claim 20.

Displaying the winning amount to the player as recited in claim 21.

The winning amount is based at least in part on at least one of: information associated with the player and at least one card accumulated

by the player or a dealer in the hand of blackjack, in which the examiner interprets the drawing the additional card to be an equivalent to information associated with the player and at least one card accumulated by the player or a dealer in the hand of blackjack (column 6, lines 10-13 and column 13, lines 44-46) as recited in claim 22.

The random outcome having a first state indicating that the player has won the hand of blackjack and a second state indicating that the player has not won the hand of blackjack, in which the examiner interprets the drawing of the additional card and the party drawing the higher (or lower) card depending rules governed by the gambling establishment to be an equivalent to the first state indicating a win or a second state indicating no win (column 6, lines 10-13 and column 13, lines 44-46) as recited in claim 23.

Receiving a wager amount associated with the hand of blackjack, determining that the hand of blackjack has resulted in a push, based on the random outcome, displaying to the player an indication of at least one of the random outcome and determination if the player has won the hand of blackjack, and arranging for the player to receive payment of the winning amount based on the wager amount (column 6, lines 10-13 and column 13, lines 44-46) as recited in claim 34.

Hesse does not expressly disclose the following:

The random outcome is statistically independent of the hand of blackjack prior to the push as recited in claims 1, 10, and 34.



Initiating a random outcome generator and receiving an indication of the random outcome as recited in claim 6.

The generating is performed using at least one die as recited in claim 12.

The random outcome has a plurality of sates, at least two of the plurality of sates being associated with different winning amounts as recited in claim 24.

Feola teaches the following:

A random outcome (spinning wheel or dice) being statistically independent of the hand blackjack and is capable of being played before or after the push, which does not change the final result of the game (column 2, line 56 - column 3, line 5 and column 3, line 57 - column 4, line 9) as recited in claims 1 and 34.

Initiating a random outcome generator and receiving an indication of the random outcome, in which the examiner interprets the rotating wheel and the results of the wheel to be equivalent to Initiating a random outcome generator and receiving an indication of the random outcome as recited in claim 6.

The generating is performed using at least one die (column 3, line 57 - column 4, line 9) as recited in claim 12.

The random outcome has a plurality of sates, at least two of the plurality of sates being associated with different winning amounts, in which the examiner interprets the tie breaker card is between ten through a King

all wheel and card bets paid to the players and ten and under goes to the establishment to be an equivalent to at least two of the plurality of sates being associated with different winning amounts (column 3, lines 1-6 and column 3, line 57 - column 4, line 9) as recited in claim 24.

By using a wheel to as a random generation to resolve a tie, one of ordinary skill in the art would provide definite unbiased game result.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hesse to include a rotating wheel a generating outcome as taught by Feola to provide definite unbiased game result.

At the time the invention was made, it would have been an obvious design choice to a person of ordinary skill in the art to provide different types of random generated outcomes using a wheel, a coin, a random number generator, a set of cards other than a set used in the hand of blackjack, and generating being performed prior to the determining that the hand of blackjack has resulted in the push as recited in claims 13-15 and 18. Lot devices are well known in the art and used for different types of gaming machine designs or applications. For example, if one were to design a table game one would use a pair of dice or if one were to design an electronic gaming machine one would use a random number generator. By having different types of lot devices, one of ordinary skill in the art would provide any type of gaming machine with a consistent random unbiased result.

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10. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hesse (US 5,803,460) in view of Feola (US 5,746,432) and Moody (US 5,954,335).

11. Hesse discloses the following:

A card game similar to the principles of blackjack determining that a first hand of blackjack has resulted in a push, and based on a random outcome, determining if the player has won the hand of blackjack, and an indication of the random outcome is displayed to the player, in which the examiner interprets the player and dealer drawing one additional card to be an equivalent to an indication of the random outcome is displayed to the player (column 6, lines 9-13 and column 13, lines 44-46) as recited in claim 31.

Hesse does not expressly disclose the following:

Determining a second hand of blackjack has resulted in a second push, an indication of the random outcome is displayed to the player, and the random outcome is statistically independent of the first hand and the second hand of blackjack played prior to the first push and second push as recited in claim 31.

The second hand of blackjack is played after the first hand of blackjack is played as recited in claim 32.

Feola teaches the following:

The random outcome being statistically independent and capable of being randomly determined before or after the push (column 3, line 57 - column 4, line 9). By having an indication or a random outcome displayed

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and the random outcome is statistically independent, one of ordinary skill in the art would provide a definite unbiased game result.

Moody teaches the following:

Playing a single or multiple hands of blackjack wherein each hand is resolved one at a time (figures 1-4) as recited in claims 31-32. By playing a single or multiple hands of blackjack wherein each hand is resolved one at a time, one of ordinary skill in the art would provide game players multiple opportunities to win whenever good hands are achieved.

By combining the random outcome being statistically independent with the single or multiple hands of blackjack wherein each hand is resolved one at a time with as taught by Feola and Moody, one of ordinary skill in the art would provide a definite unbiased game result for each hand played based on predetermined criteria.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hesse to further include the random outcome being statistically independent with each of the single or multiple hands that have resulted in a push as taught by combination of Feola and Moody would provide game players a definite unbiased game results for each hand played based on predetermined criteria

12. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Molnick (US 5,800,268) in view of Feola (US 5,746,432).

13. Molnick discloses the following:

A blackjack game having the dealer receiving an indication that the hand of blackjack has resulted in a push (figure 4 item 72) and transmitting, via communication network information from the player to the dealer and the dealer transmitting information regarding the outcome of the game (summary and figures 1-4).

Molnick does not expressly disclose the following:

A random outcome in response to the hand of blackjack has resulted in a push and the random outcome determining if the player has won the hand of blackjack.

Feola teaches the following:

A blackjack type game having a random outcome (die) in response to the hand of blackjack has resulted in a push (tie) and the random outcome determining if the player has won the hand of blackjack (column 3, line 57 - column 4, line 9). By having a random outcome determining if the player has won in the even of a tie, one of ordinary skill in the art would provide game players with a definite winner of a game.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Molnick to include a random outcome in response to the hand of blackjack has resulted in a push and the random outcome determining if the player has won the hand of blackjack as taught by Feola to provide game players with a definite winner of a game.

*Response to Arguments*

14. Applicant's arguments with respect to claims 1-4, 6-10, 12-16, 18-24, and 31-34 have been considered but are moot in view of the new ground(s) of rejection.

The applicants contend that claim 34 provide a concrete result with the limitation of, "displaying to the player an indication of at least one of (i) the random outcome and (ii) the determination if the player has won the hand of blackjack."

As noted above displaying an indication can be broadly interpreted to just be a dealer pointing to the something like cards on the table or a random outcome like the outcome of a pair of die. Although a determination is made regarding the hand or a plurality of hands blackjack, the result is never functionally used or displayed.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine Feola with Hesse can be found in Feola by giving the claims their broadest reasonable interpretation. As noted above Feola does not expressly disclose the random outcome being statistically independent of the hand of blackjack played prior to the push. Feola teaches a blackjack (twenty-one) type game wherein after the event of a tie (push) a dice is rolled to determine if the player or the dealer ultimately wins according to some predetermined arrangements (column 3, line 57 - column 4, line 9).

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Feola also teaches a random outcome being statistically independent of the hand of blackjack. Where in the event of a tie, a dice is rolled to determine if the player or the dealer (house) wins. The examiner agrees that the statistically independent random outcome happens after a push (tie) is decided and not before, however having the random outcome happen before or after the decision of the push (tie) does not change the final outcome of the game. Applicants do not provide criticality that by having the random outcome played before the push (tie) provides an advantage over the random outcome played after the decision of a push (tie) takes place. Regardless when the random outcome takes place before or after does change results of the game. Having a separate independent lot device like a dice or spinning wheel to decide an outcome would provide an unbiased game result. By having different types of independent lot devices to resolve a push (tie), one of ordinary skill in the art would provide any type of game with a consistent random unbiased result.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APR

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a horizontal line and a small upward stroke.

JESSICA HARRISON  
PRIMARY EXAMINER